



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,714	02/04/2004	Mark J. Cleaver	0232W/00028-U	4133
24350	7590	04/19/2005	EXAMINER	
STITES & HARBISON, PLLC 400 W MARKET ST SUITE 1800 LOUISVILLE, KY 40202-3352			SAWHNEY, HARGOBIND S	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,714

Applicant(s)

CLEAVER ET AL.

Examiner

Hargobind S. Sawhney

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/04, 5/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 7, 10-17, and 19-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-3, 5-8 and 12 of Copending Application No. 10/413,005. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Instant Application No. 10,670,003	Copending Application No. 10/413,005	Discussion on differences, and additional References:
Claims 1, 2	Claim 1	<p>Copending Application No. 10/413,005 claims an illumination device including:</p> <ul style="list-style-type: none">- substantially rod-like member with a light transmitting surface and a light receiving surface; an elongated and substantially flexible light source extending along the light receiving surface (Claim 1, lines 1-15);- a flexible housing accommodating a flexible circuit board, and the housing extending along the light receiving surface of the rod-like member (Claim 5);- the rod-like member comprising a flexible compound filler detecting and scattering the light (Claim 1, lines 1-7); <p>Thus, claims 1 and 5 in combination meet the limitations of claims 1 and 2 of the instant application.</p>
Claims 7-10	Claims 5 and 12	<p>Copending Application No. 10/413,005 claims an illumination device including:</p> <ul style="list-style-type: none">- a housing enclosing a light source; the housing positioned below and extending along the rod-like member; and the light from the light source emits into the light receiving member of the rod-like member (Claim 5);

Instant Application No. 10,670,003	Copending Application No. 10/413,005	Discussion on differences, and additional References:
Claims 7-10 Cont'd.	Claims 5 and 12 cont'd.	<ul style="list-style-type: none">- the housing, with two side walls and a bottom, extending along the light receiving surface of the rod-like member (Claims 5 and 12);- the housing having its internal surfaces provided with reflecting material (Claims 5 and 12);
Claims 11 and 12	Claims 6, 7 and 8	Copending Application No. 10/413,005 claims an illumination device including: <ul style="list-style-type: none">- a flexible circuit board received in the open-ended channel defined by the walls (Claims 6 and 6);- the positions of the light source and flexible circuit board being maintained with a flexible potting material (Claim 8);
Claims 13 and 14	Claims 2 and 3	Copending Application No. 10/413,005 claims an illumination device including: <ul style="list-style-type: none">- the light source including a plurality of spaced point-light sources extending linearly along the light receiving surface of the rod-like member (Claim 2);

Instant Application No. 10,670,003	Copending Application No. 10/413,005	Discussion on differences, and additional References:
Claims 13 and 14	Claims 2 and 3	- the light source including light emitting diodes- LEDs) - (Claim 14);
Claim 15	Claim 5	Copending Application No. 10/413,005 claims an illumination device including: - a housing enclosing a light source; the housing positioned below and extending along the rod-like member; and the light from the light source emits into the light receiving member of the rod-like member (Claim 5); - the housing, with two side walls and a bottom, extending along the light receiving surface of the rod-like member (Claims 5 and 12);
Claim 16	Claim 6	Copending Application No. 10/413,005 claims an illumination device including: - a flexible circuit board received in the open- ended channel defined by the walls (Claims 6 and 6);
Claim 17	Claim 8	- the positions of the light source and flexible circuit board being maintained with a flexible potting material (Claim 8);

Instant Application No. 10,670,003	Copending Application No. 10/413,005	Discussion on differences, and additional References:
Claims 19-24	Claims 1-3, 5-8 and 12	<p>Copending Application No. 10/413,005 claims an illumination device:</p> <ul style="list-style-type: none">- solid rod-like member composed of a flexible compound impregnated with filler; an elongate light source positioned adjacent the rod-like member; a housing having reflective inner surfaces defined by two parallel walls and a bottom; the housing cavity filled with a filler material having substantially similar optical properties; and the elongated light source including LEDs (Claims 1-3, 5-8 and 12) as detailed above. <p>It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the method limitations of claims 19-24 of the instant application by applying the teaching recited in Claims 1-3, 5-8 and 12 of the co pending application.</p>

It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 1-6 of the instant application with the structural limitations included in respective claims 2, 5, 3, 6 and 4 of U. S. Patent No. 6,626,550 B2.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 3 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending application 10/413,005 in view of Nojiri et al. (US Patent No.: 6,366,727B1).

Regarding Claims 3 and 4, dependent on claims 1 and 2 respectively; the Copending application 10/413,005 claims a rod-like member composed of flexible material, and the flexible material being impregnated with filler (Claims 1 and 2). However, the copending application 10/413,005 does not claim either the flexible material or filler being polyurethane, silicone or silicone rubber as claimed by claims 3 and 4.

On the other hand, Nojiri et al. ('727B1) discloses a light illuminating rod composed of either a silicone resin or a silicone rubber (Column 1, lines 60 and 61).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the rod-like member of the co-pending application by the rod-like member composed of either a silicone resin or a silicone rubber as taught by Nojiri et al.

('727B1) for benefit and advantage of providing a rod-like member with structural flexibility and comparatively high refractive index.

4. Claims 5 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending application 10/413,005 in view of Nojiri et al. (US Patent No.: 6,366,727 B1) as applied to respective claims 3 and 4 above, and further in view of Zamja et al. (US Patent No.: 4,195,907).

Regarding claims 5 and 6, dependent on claims 4 and respectively, the copending application 10/413,005) in view of Nojiri et al ('727 B1) teaches a rod-like member formed of a flexible silicone rubber. However, neither combined nor individual teachings of the copending application 10/413,005) and Nojiri et al ('727 B1) disclose a rod-like member additionally include micro air balloons.

On the other hand, Zamja et al. ('907) discloses a light-conducting rod-like member 94 formed of a flexible material having micro air- balloons 92 (Figures 3 and 5, column 3, lines 22-28).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the rod-like member of the co-pending application 10/413,005 in view of Nojiri et al. ('727B1) by the rod-like member composed of a flexible material with impregnated air-balloons as taught by Zamja et al. ('907) for benefit and advantage of providing lateral reflection of light for decorative effects.

5. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending application 10/413,005 in view of Ghandehari (US Patent No.: 5,537,297).

Co pending application 10/413,005 claims a rod-like member composed of flexible material (Claims 1 and 2). However, the co pending application 10/413,005 does not claim the rod-like member further including a collection surface adjacent a portion of the outer surface of the rod-like member, and the collection surface positioned near the light source as claimed in Claim 18 of the instant application.

On the other hand, Ghandehari ('297) discloses a a reflecting light guide device including a rod-like member 12 including a collection surface 50 positioned near a light source 15 (Figures 1-3, column 3, lines 17-21 and 55- 55-59).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the rod-like member of the co-pending application by the rod-like member with a collection surface as taught by Ghandehari ('297) for benefit and advantages of controlling the direction of the light reflected through the rod-like member.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Wortman et al. (U.S. Patent No. 6,447,135 B1), Lekson et al. (U.S. Patent No. 6,305,813 B1), Onishi et al. (U.S. Patent No. 6,086,212) and Marinelli et al. (U.S. Patent No. 5,890,796)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS
4/16/05


Stephen Husar
Primary Examiner